



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,176	11/25/2003	Peter J. Shank	BSX-228	4334
24972	7590	03/26/2009		
FULBRIGHT & JAWORSKI, LLP			EXAMINER	
666 FIFTH AVE			SHARMA, YASHITA	
NEW YORK, NY 10103-3198				
		ART UNIT	PAPER NUMBER	
		3774		
		MAIL DATE	DELIVERY MODE	
		03/26/2009 PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER J. SHANK and F. ANTHONY HEADLEY, JR.

Appeal 2008-5540
Application 10/720,176
Technology Center 3700

Decided:¹ March 25, 2009

Before TONI R. SCHEINER, DONALD E. ADAMS, and FRANCISCO C.
PRATS, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON REQUEST FOR REHEARING

Appellants have requested reconsideration of the decision entered December 18, 2008 (“Decision”), affirming the rejection of claims 2, 3, 7, 22-24, and 28-35 as anticipated. The request for rehearing is denied.

DISCUSSION

Appellants first urge that reconsideration is required because the Decision erroneously found that the outer sleeve of Hossainy’s stent exerts sufficient force to avoid collapsing when subjected to compressive forces (Req. Reh’g 1-2 (citing Decision 11, 12)). This argument essentially repeats the contentions made in the Appeal Brief and Reply Brief that Hossainy’s outer element cannot be a stent because it is disclosed as exerting a weak restoring force (*see* App. Br. 13; Reply Br. 4, 5).

This argument does not demonstrate that rehearing is required. While Appellants’ arguments express disagreement with our ultimate findings in the Decision, they do not “state with particularity the points believed to have been misapprehended or overlooked by the Board,” as required under 37 C.F.R. § 41.52. That is, while Appellants disagree with the outcome of the Decision, Appellants have not shown that the Decision failed to adequately appreciate or address the arguments Appellants presented in the Appeal Brief and Reply Brief.

Appellants further argue:

[I]n contrast to the assertion that Appellants have not argued and therefore concede that Hossainy meets the limitations in claim 23 directed to the inner metal stent (Decision, page 8, first full par.), and therefore waived any argument, Appellants have consistently argued that Hossainy does not disclose any inner stent. Attention is drawn to page 11 of the Appeal Brief, where Appellants do in fact argue that

Hossainy does not disclose an inner stent, as it is argued that Hossainy discloses a single stent structure in Figures 2 and 3. The Examiner also failed to assert Figure 1 as anticipating the claimed subject matter. Thus, contrary to page 8, first full paragraph of the Decision, Appellants have in fact argued and have not conceded that Hossainy meets the limitations of claim 23 directed to the inner metal stent.

(Req. Reh'g 2.)

We are not persuaded that the Decision overlooked or misapprehended arguments Appellants presented in the Appeal Brief or Reply Brief, to the effect that Hossainy failed to describe an inner stent as recited in claim 23. We acknowledge the statement, on page 11 of the Appeal Brief, that “Hossainy *et al.* nowhere discloses or suggests any composite stent including *both* an inner stent and also an outer stent where both stents are structural support devices for body orifices, cavities, etc. that both can be compressed and expanded from a collapsed configuration” (App. Br. 11).

However, while Appellants disagree that the outer element of Hossainy's composite stent is, in fact, a stent, Appellants fail to direct our attention to any portion of their Appeal Brief or Reply Brief that would support a finding that the *inner element* of Hossainy's composite stent does not meet the requirements of the limitations in claim 23 directed to an inner metal stent.

Appellants argue that, “although claim 23 was cited in the Decision as a representative claim, the Decision is devoid of any discussion of the interpretation of the feature in claim 23 requiring the self-expanding metal stent to be ‘releasably engageable’ within a bioabsorbable stent” (Req. Reh'g 2). In this regard, Appellants further urge that “if Hossainy's tube

(outer covering) is compression-fitted, then Hossainy's stent 100 cannot be releasably engageable within Hossainy's bands 209 or disclosure of a compression fitted sleeve are interpreted as an outer stent, nothing in Hossainy discloses that the outer stent is releasable engageable from the inner stent" (*id.* at 3).

We are not persuaded by these arguments. Appellants have pointed to no evidence of record showing that Hossainy's inner sleeve would fail to be releasably engageable from the outer sleeve merely because the outer sleeve is compression fitted.

Moreover, as discussed above, Appellants' arguments in the Appeal Brief and Reply Brief were directed to the alleged error in the Examiner's finding that the outer element of Hossainy's composite stent could be considered a stent. While the Examiner cited the passage in Hossainy describing the outer stent as being a compression fitted sleeve (Ans. 3 (citing Hossainy, col. 2, l. 60, through col. 3, l. 10)), Appellants did not allege any error in the Examiner's implicit finding that Hossainy's inner stent was releasably engageable from within the outer stent (*see* App. Br. 9-16; Reply Br. 2-5).

Thus, because Appellants did not allege that Hossainy's composite stent failed to meet claim 23's limitation requiring the inner stent to be releasably engageable from the outer stent, the Decision did not address any argument to that effect. We are therefore not convinced that the points Appellants made in the Appeal Brief or Reply Brief were misapprehended or overlooked.

SUMMARY

Appellants' arguments do not persuade us that our decision affirming the Examiner's rejection of claims 2, 3, 7, 22-24, and 28-35 as anticipated has misapprehended or overlooked any point of fact or law. We therefore decline to modify our original decision entered December 18, 2008.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REHEARING DENIED

mls

FULBRIGHT & JAWORSKI, LLP
666 FIFTH AVE
NEW YORK NY 10103-3198